

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Eric J. Howell et al.	Examiner: Robert Rines
Serial No.:	10/016,302	Group Art Unit: 3626
Filed:	October 29, 2001	Docket: 2185.001US1
Title:	METHOD AND APPARATUS FOR PROCESSING HEALTH INSURANCE APPLICATIONS OVER A NETWORK	

REPLY BRIEF TO EXAMINER'S ANSWER UNDER 37 CFR 41.41

Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
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Appellants file this Reply Brief in response to the Examiner's Answer dated June 25, 2008.

The Combination of Lencki, Wolff, and Smithies is not Proper

In the Examiner's answer, Examiner asserts that, in many situations, there is neither a motivation to make the modification clearly articulated in the references nor an evident lack of motivation. (Examiner's Answer, pages 34-35.) It is submitted that the argument set forth in the appeal brief does not discuss whether a motivation to combine the cited references is articulated in the references themselves. Rather, the discussion is focused on whether Examiner's reasoning for combining Lencki, Wolff, and Smithies supports the legal conclusion of obviousness. As emphasized by the court in *In re Kahn*, "[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."¹ In the Examiner's answer, Examiner discusses the combination of references that includes Smithies, but does not address the Appellants' assertion that the combination of Wolff and Lencki is improper. The answer merely repeats the Appellants' assertion without responding to it.

In an earlier section, on pages 32 and 33, Examiner stresses that bidding, discussed in the Appeal Brief in the context of the discussion of whether the combination of Lencki and Wolff is proper, is not claimed in the Appellants' claims. It is submitted that bidding is discussed by

Appellants in the context of whether a person skilled in the art presented with Lencki that addresses the step where a consumer (an employer) has already made a decision regarding the selection of the insurance provider and is now allowing the employees to fine tune the selection of benefits offered by the provider (Lencki, [0081], [0082]) would be motivated to look to Wolff, directed at soliciting bids. While bidding is not recited in any of the Appellants' claims, the purpose of Wolff being to permit bidding is relevant to the discussion of whether the combination of Wolff and Lencki is proper.

Thus, Examiner failed to provide a reasoned rationale for obviousness in view of Lencki and Wolff, and therefore the combination of Lencki and Wolff fails to make a prima facie showing of obviousness. It is respectfully requested that the rejections in view of Lencki and Wolff combination be reversed.

Wolff Teaches Away From the Subject Matter of the Rejected Claims

In the Examiner's Answer, Examiner stresses that bidding is not claimed in the Appellants' claims. As explained above, bidding is discussed by Appellants to show that Wolff teaches away from the claimed invention and that a person skilled in the art would not be motivated to combine Lencki and Wolff. Examiner states the following.

¹ *In re Kahn*, 2006 WL 708687, *10 (Fed. Cir. 2006) (quoted in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007)).

In response, Examiner notes that the bidding process described by Wolff et al. is not an element of Applicant's claimed invention nor is it relied upon by the Examiner in the rejection of the claimed invention. Examiner respectfully submits that Wolff is applied by the Examiner merely to evidence a practice well-known to both the e-commerce art at large as well as the specific insurance subset of the e-commerce art, namely, the assembly of information into a secure file for transmission to a recipient via a network. Accordingly, Examiner submits that the downstream functionality of Wolff (including the bidding process) is immaterial to the Examiner's stated reasons for rejecting the claim. Further, as both Lencki et al. and Wolff et al. are directed to the network or Internet enabled insurance application and purchase process, Examiner submits that they are analogous art and therefore maintains that the combination is proper.

(Examiner's Answer, pages 36-37.)

While Examiner cited Wolff to show one of several claimed features, the issue remains to be whether combining Wolff and Lencki to show the claimed invention was proper. The purpose of Wolff being to permit collecting bids from multiple insurers (termed by Examiner as "downstream functionality") is relevant to the determination of whether the claimed invention is obvious in view of the combination of Lencki and Wolff. Furthermore, the purpose of Wolff being to permit obtaining underwriting decisions from multiple insurers (bidding) is also relevant to the determination of whether the reference as a whole teaches away from the claimed invention. As provided in MPEP section 2185.02, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.²

While Examiner states that Wolff was applied to evidence the assembly of information into a secure file, Examiner ignores the notion that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention and

² *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983).

also fails to address the Appellants' assertion that Wolff teaches away from the subject matter of the rejected claims.

*Lencki, Wolff, and Smithies Combination Does Not Disclose Each Element of the
Rejected Claims*

In the Examiner's Answer, Examiner explains, that Wolff was applied to evidence the assembly of information into a secure file. (Examiner's Answer, pages 36-37.) Specifically, Examiner states the following.

Wolff et al. teach transforming the application data into a secure digital file; and transmitting the secure digital file (Wolff et al.; paragraphs [0015] [0017] [0018]) to the health insurance carrier. Additionally, Wolff et al. disclose customizing the secure document to include any information required by a specific carrier (Wolff et al.; paragraph [0018]) and upon acceptance of an insurance bid, transforming the applicant's information into an official approved insurance application (i.e., finalized application) (Wolff et al.; paragraph [0020]). Though directed to the life insurance application process, Examiner submits that the secure document assembly and transmission of insurance application data disclosed by Wolff et al. and noted above are applicable to an insurance application process as a matter of user choice. Accordingly, Wolff et al. disclose transforming the health insurance application data into a secure digital file thereby creating a finalized health insurance application; and transmitting the secure digital file to the health insurance carrier (Wolff et al.; paragraphs [0015] [0017] [0018] [0020]).

As pointed out in the Appeal Brief, the insurability documentation file (IDF) disclosed in Wolff is electronically transmitted over a secure network to participating insurance companies in order to evaluate the insurability of the prospective insured party (Wolff, [0018]). It is submitted that an electronic document that is not a secure digital file (e.g., a document that may be edited) may be transmitted over a secure network. Thus, while Wolff discloses transmitting the insurability documentation file over a secure network, Wolff fails to disclose "transforming the client data into a secure digital file," as recited in claim 1. Examiner does not address in the Answer Applicants' explanation that an electronic document that is not a secure digital file may be transmitted over a secure network and therefore it is not proper to infer that an IDF

transmitted over a secure network is itself a secure digital file.

In the Examiner's Answer, Examiner states the following.

In response to Appellant's third argument, Appellant correctly notes that Examiner is reliant on the teachings of Wolff in addressing the limitation directed to "transforming the client data into a secure digital file". However, Examiner respectfully disagrees with Appellant's interpretation of that the assembly the "Insurability Documentation File" containing "the information needed by insurers to evaluate the insurability rating of the prospective insured party" disclosed by Wolff and acknowledged by Applicant, is distinct from an insurance application. Examiner maintains that the transmission of "information needed to underwrite" a policy from an applicant to an insurer constitutes a form of "insurance application". Examiner maintains that the secure transmission of the insurability document file, disclosed by Wolff et al., and noted above in the grounds of rejection is the functional equivalent of the "creating a secure document" as recited in the finally rejected claims.

(Examiner's Answer, pages 37-38.)

As shown in the quoted passage above, Examiner fails to acknowledge that the feature recited in the claims is a "finalized insurance application," and instead remarks that "information needed to underwrite" a policy constitutes a form of "insurance application." Examiner does not address Appellants' argument explaining that the insurance application form referred to in Wolff is not the same as the insurability documentation file (cited by the Office action to show a secure digital file) and the fact that there is no indication in Wolff that the insurance application *form* does not need to be filled out or at least signed by the customer, and thus is not a secure digital file and also cannot be regarded as a finalized health insurance application.

Thus, Appellants maintain that, because the combination of Lencki, Wolff, and Smithies does not teach all limitations of claim 1, the Examiner failed to establish *prima facie* obviousness

of claim 1. It is respectfully requested that the rejection be reversed.

Summary

Appellants' reply to Examiner's Answer can be summarized as follows. First, Examiner did not traverse the assertion that the combination of Lencki and Wolff is improper, but only discussed the relevance of Smithies. Second, Examiner asserted that Wolff was applied to evidence the assembly of information into a secure file, but failed to acknowledge the notion that a prior art reference must be considered as a whole, including portions that would lead away from the claimed invention. and also fails to address the Appellants' assertion that Wolff teaches away from the subject matter of the rejected claims. Thirdly, Examiner failed to address Applicants' explanation that an electronic document that is not a secure digital file may be transmitted over a secure network and therefore the references to an IDF in Wolff do not read on "a secure digital file" recited in claim 1. Fourthly, Examiner failed to address Appellants' argument explaining that the insurance application form referred to in Wolff is not the same as the insurability documentation file and the fact that there is no indication in Wolff that the insurance application *form* does not need to be filled out or at least signed by the customer, and thus is not a secure digital file and also cannot be regarded as "a finalized health insurance application" recited in claim 1.

For the reasons articulated above, with respect to claims 1-49, Applicants maintain that Examiner failed to make prima facie showing of obviousness under 35 USC § 103(a) in view of the combination of Lencki, Wolff, and Smithies. It is respectfully submitted that the art cited does not render the claims 1-49 obvious and that the claims are patentable over the cited art. Reversal of the rejection and allowance of the pending claims are respectfully requested.

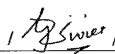
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Respectfully submitted,

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